

In re Benno 226 USPQ 683, 686 (Fed. Cir. 1985)

To summarize our view of the Danti patent as a reference, we find nothing in it in common with appellant's claimed invention other than the fact that it discloses beverage cans wrapped in plastic film apparently similar to the film used by appellant. The stack of cans is different and the wrapping is different. Danti uses a platform which appellant does not use and does not deal with the problem appellant deals with. What Danti does disclose could not possibly have made appellant's invention obvious. The examiner did not contend that it did.

[1] The board, nevertheless, reached the opposite conclusion by what we consider to be a plainly indefensible line of reasoning. Danti's claim 1, the board said, "is broad enough to read on a package with the inner web encircling the containers in a horizontal direction and the outer web encircling the containers in a vertical direction. . . ." That is appellant's claimed invention, in major part. Therefore, reasoned the board, that configuration would have been obvious from Danti, which is a non sequitur.

Samuel F. B. Morse, the inventor of the telegraph, had a patent thereon, issued in 1840, containing a claim (which the Supreme Court held invalid) which was broad enough to read on the modern Telex. *See O'Reilly v. Morse*, 56 U.S. 62, 112 (1853). By the board's reasoning, Morse's telegraph patent therefore would have made the Telex obvious. The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding. While it is true, as the Solicitor suggested at oral argument, that "a claim is part of the disclosure," that point is of significance principally in the situation where a patent application as filed contains a claim which specifically discloses something not disclosed in the descriptive part of the specification (claims being technically

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part of the "specification," 35 USC 112, 2d par.), in which case the applicant may amend the specification without being charged with adding "new matter," within the meaning of §132. See 37 CFR 1.118. ("All amendments to the specification, including the claims, and the drawings filed after the filing date of the application *must conform to at least one of them* as it was at the time of filing the application." (Emphasis ours.)) But that is not the situation here. Danti's claim 1 does not disclose any structure additional to what the Danti specification discloses.

For the above reasons, we hold that the board erred in relying on Danti's claim 1 in deciding that appellant's claims would have been obvious from that reference alone and also in reaching that conclusion.